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OFFICE OF PETITIONS

In re Application of :
Lehman et al. :
Application No. 10/015,583 : **ON PETITION**
Filed: 17 December, 2001 :
Attorney Docket No. T3292-907823 :

This is a decision on the petition filed on 1 November, 2004, under 37 CFR 1.47(a) and 1.48(a)(1) which is being treated as (a) a petition under 37 CFR 1.48(a)(1) requesting that a person be added as inventor and (b) a petition under 37 CFR 1.183 requesting waiver of 37 CFR 1.63 and 1.67, which require that a named inventor execute a supplemental declaration.

The petition is **DISMISSED**.

Any request for reconsideration of this decision must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. **FAILURE TO TIMELY RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** The reconsideration request should include a cover letter entitled "Renewed Petition Under 1.48(a) and 1.183."

On 17 December, 2001, the above-identified application was filed. The original application papers included, a declaration under 37 CFR 1.63 was filed naming William R. Lehman as the sole inventor.

On 1 November, 2004, the present petition was filed, whereby petitioners seek to add David A. Stout as a joint inventor. Petitioners further state that joint inventor Lehman has refused to sign the declaration naming the actual inventors as required by 37 CFR 1.48(a)(3).

Petition Under 37 CFR 1.48(a)

37 CFR 1.48(a) requires that an amendment to the named inventive entity be accompanied by:

(1) a petition including a statement from each person being added and each person being deleted as an inventor that the error occurred without deceptive intention on his or her part;

(2) an oath or declaration by each actual inventor or inventors as required by 37 CFR 1.63 or as permitted by 37 CFR 1.42, 1.43 or 1.47;

(3) the fee set forth in 37 CFR 1.17(i), and

(4) the written consent of any existing assignee, if any of the originally named inventors has executed an assignment.

The petition lacks item (4) in that petitioners have not provided the written consent of the assignee. It is noted that while the petition under 37 CFR 1.48(a) references the filing of consent of the assignee, no statement of consent could be located among the papers received with the present petition. Rather, petitioners have simply provided a statement under 37 CFR 3.73(b) and a copy of the assignment itself. Any renewed petition should be accompanied by the written consent of the assignee.

Petition Under 37 CFR 1.183

Petitioners state that Lehman has refused to sign a supplemental declaration naming the inventive entity, and request waiver under 37 CFR 1.183 of the requirement of 37 CFR 1.48(a)(2) of an oath or declaration signed by each actual inventor in that Lehman refuses to sign the declaration.

In view of the dismissal of the petition under 37 CFR 1.48(a) as stated above, the requirements for a petition under 37 CFR 1.183 to waive 1.63 and 1.67 have not been met. Therefore the petition under 37 CFR 1.183 must be dismissed. However, such dismissal is without prejudice to reconsideration pending submission of a grantable petition under 37 CFR 1.48(a).

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop Petition
 Commissioner for Patents
 P.O. Box 1450
 Alexandria, VA 22313-1450

By FAX: (703) 872-9306
 Attn: Office of Petitions

By hand: Customer Service Window
 Mail Stop Petition
 Randolph Building
 401 Dulany Street
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Telephone inquiries concerning this matter may be directed to the undersigned at (571)272-3231.



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